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In re Application of
FINDLAY, John
Serial No.: 09/913,522
PCT No.: PCT/GB00/00517
Int. Filing Date: 17 February 2000
Priority Date: 18 February 1999
Atty. Docket No.: 9052.988
For: MODIFIED CALYCINS

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DECISION ON PETITION
UNDER 37 CFR 1.181
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This decision is issued in response to applicants' "Renewed Petition under 37 CFR 1.181" filed 16 May 2006. No petition fee is due.

BACKGROUND

On 17 February 2000, applicant filed international application no. PCT/GB00/00517 which claimed a priority date of 18 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 August 2000. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 18 August 2001.

On 13 August 2001, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 09 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration. The notification set a two-month time limit in which to respond.

On 10 December 2001, applicant filed an executed declaration.

On 28 January 2002, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) which set forth a 35 U.S.C. 371 completion date of 08 November 2001.

On 27 February 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form

PCT/DO/EO/905) indicating that the sequence listing was not in compliance with 37 CFR 1.821-1.825 in that a copy of the "sequence listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). Additionally, the United States Designated/Elected Office (DO/EO/US) mailed "Withdrawal of Previously Sent Notice" which indicated that the Notice (of Acceptance) mailed on 28 January 2002 was sent in error.

On 07 May 2002, applicant filed "Statement in Support of Filing a Sequence Listing under 37 CFR 1.821(f)" which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable form of the sequence listing.

On 30 July 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A computer readable that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d)."

On 12 August 2002, applicant filed "Statement in Support of Filing a Substitute Sequence Listing under 37 CFR 1.821(f)" which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable form of the sequence listing.

On 17 October 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825.¹

On 28 October 2002, applicant filed "Statement in Support of Filing a Substitute Sequence Listing under 37 CFR 1.821(f)" which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable form of the sequence listing.

On 22 June 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A computer readable that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d)."

¹The United States Designated/Elected Office should have mailed a Notification of Abandonment (Form/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 27 February 2002 since the time period to respond had expired.

On 21 July 2004, applicant filed "Response under 37 CFR 1.825(d) and Statement in Support of Filing a Substitute Sequence Listing under 37 CFR 1.821(f) which included a Statement under 37 CFR 1.821(e) with a hard copy and a computer readable form of the sequence listing.

On 30 July 2004, the PALM Database indicated that a compliant computer readable form (CRF) had been submitted.

On 05 April 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 27 February 2002 within the time period set therein.

On 09 May 2005, applicant filed a petition to withdraw the holding of abandonment under 37 CFR 1.181. In a decision dated 16 March 2006, applicant's petition to withdraw the holding of abandonment was dismissed without prejudice.

On 16 May 2006, applicant filed the present petition to petition to withdraw the holding of abandonment under 37 CFR 1.181.

DISCUSSION

The above-identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 27 February 2002, in that, the sequence listing in computer readable form complying with 37 CFR 1.821-1.825 had not been submitted within the period set therein. As stated in the previous decision, since the Notification of Missing Requirements was mailed on 27 February 2002, applicants were required to submit a response by 27 April 2002. If applicant elected to use to the provisions under 37 CFR 1.136, applicants would be required to file a complete response by 27 September 2002.

Applicant states in their present petition that a response to the Notification of Missing Requirements was deposited on 29 April 2002 with the United States Postal Service in accordance with 37 CFR 1.8. However, the 29 April 2002 (and the 12 August 2002 and the 28 October 2002) submission did not comply with the requirements of 37 CFR 1.822 and/or 1.823 as indicated on the Notification of Defective Response mailed on 30 July 2002 because the CRF was damaged. In this regard, it is noted that the CRF was mailed to the "20231" zip code, which mail was then being subjected to radiation. See USPTO Notice dated 28 January 2002 advising application not to send CRF to this zip code, but rather to an alternative address. (See also www.uspto.gov/emergencyalerts/mailqanda.htm.) This warning also appeared on the CRF Problem Report.

It is noted that the United States Patent and Trademark Office erred in issuing the 17 October 2002 and 22 June 2004 Notification of Defective Response as the application was already abandoned for failure to timely submit a CRF in compliance with the sequence listing rules within the time period set in the Notification of Missing Requirements. The Manual of Patent Examining Procedure §714.03, page 700-231, states that "once an

inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c).

Therefore, the USPTO was correct in mailing the Notification of Abandonment dated 05 April 2005 and the petition may not be properly granted.

CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED** without prejudice and the application remains **ABANDONED**.

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137. This recommendation to file a petition under 37 CFR 1.137(b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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